

### **REMARKS/ARGUMENTS**

Reconsideration and continued examination of the above-identified application are respectfully requested.

Claims 1-5, 7, 9-11, 13-29, 31-58, and 60-135 are pending in the application. Claims 12, 30, and 59 were previously canceled and claims 6 and 8 are canceled by this amendment. Claims 35-55 and 61-134 are currently withdrawn from consideration. Claims 1 and 56 has been amended by way of this amendment. Support can be found in the present application, including paragraphs [0040] and [0079] to [0085] and the examples and claims as originally filed. No new matter is introduced and entry of this amendment is respectfully requested.

#### **Double Patenting Rejection**

At page 2 of the Office Action, the Examiner provisionally rejects claims 1-11, 13-29, 31-34, 56-60, and 135 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-66 and claims 1-43 of co-pending U.S. Patent Application No. 10/650,124 and U.S. Patent Application No. 10/649,347, respectively. This rejection is respectfully traversed.

While the Examiner has not provided any reasoning on why the claims of the co-pending applications would be obvious in view of the rejected claims, to expedite prosecution of this application, and without agreeing to the Examiner's conclusions, submitted with this response is a Terminal Disclaimer.

Accordingly, this rejection should be withdrawn.

**Rejection under 35 U.S.C. §102(b)**

At pages 2-3 of the Office Action, the Examiner rejects claims 1-5, 9-11, 13-29, 31-34, 56-60, and 135 under 35 U.S.C. §102(b) as being anticipated Cuch et al. (U.S. Patent No. 6,482,883). This rejection is respectfully traversed.

Cuch et al. does not teach or even suggest the claimed invention. Cuch et al. relates to an inkjet coating composition placed on paper and does not relate to a method of forming a composition having a particulate material and matrix based on measuring the homogenous interaction parameter for the particulate material itself and also based on at least "performance property" of the composition, as those terms are defined in the present application.

The Examiner primarily relies on the "Black Wicking Rating" described in Cuch et al., primarily at cols. 9 and 10. However, closer examination of the sections of Cuch et al. clearly teach a wicking rating test that does not measure at least one homogenous interaction parameter for the particulate material alone. The black wicking rating described at cols. 9 and 10 of Cuch et al. and relied upon by the Examiner to reject the claims only relates to a printing performance test of the overall coating composition and did not determine or take into consideration the interaction between the silica and how the silica interacts with itself and also with the matrix that it is present in. The Examiner alleged that the black wicking rating reads on the claimed "homogenous interaction parameter . . . relates to how the particulate material interacts with itself . . . " However, this is not accurate. Claim 1 and the claims of the present application recite measuring at least one homogenous interaction parameter for the candidate material itself and how that particulate material interacts with itself and, clearly, the black wicking rating, described at cols. 9 and 10, is a wicking rating for the overall coating material that contains all of the components and there is no measurement or understanding of the silica and how that silica interacts by itself with respect to

wicking. Essentially, the black wicking rating of Cuch et al. relates to a performance property as opposed to a homogenous interaction parameter and simply identifies how well an image can be printed on a piece of paper without wicking. This has nothing to do with understanding a particulate material and the homogenous interaction parameter of the particulate material. Certainly, no section of Cuch et al. describes a method of forming a composition with a particulate material and matrix by first providing a candidate particulate material and measuring the homogenous interaction parameter, and taking into account as recited in claim 1, the performance property of the composition and the homogenous interaction parameter of the particulate material. For these reasons, the claims are not taught or suggested by Cuch et al.

In addition, it may assist the Examiner to see a detailed presentation of the interfacial potential of wicking rates described in, for instance, paragraph [0065] of the present application. Clearly, the description of this test and the information gathered from this test is quite different from the "Black Wicking Rating" described in Cuch et al. Again, the wicking rating of Cuch et al. relates to printing on paper that contains the inkjet coating of Cuch et al. to determine the wicking of the ink that is printed on the coated paper and, therefore, there is no separate understanding or measuring of a wicking rate of the particulate material by itself, contrary to the position taken by the Examiner.

Accordingly, this rejection should be withdrawn.

**Rejection under 35 U.S.C. §103(a)**

At page 4 of the Office Action, the Examiner rejects claims 6-8 under 35 U.S.C. §103(a) as being unpatentable over Cuch et al. in view of Sampei (U.S. Patent No. 7,021,213). This rejection is respectfully traversed.

The Examiner relies on Sampei to assert that ink compositions can contain carbon black and silica. Otherwise, the Examiner relies on Cuch et al. to reject the claims in the same manner as set forth above in the §102 rejection. This rejection is respectfully traversed.

For the reasons set forth above, Cuch et al., alone or in combination with Sampei, does not teach or suggest the claimed invention. Sampei does not teach or suggest the numerous deficiencies mentioned above with respect to Cuch et al., and, therefore, even if combinable with Cuch et al., does not teach or suggest the claimed invention.

With regard to the Examiner's assertion that it would be obvious to combine Cuch et al. with Sampei, the applicants disagree with the Examiner's position in this matter. The Examiner appears to have misunderstood the alleged teachings of Cuch et al. In particular, as stated above, Cuch et al. relates to an inkjet coating composition that contains silicas and other ingredients and this composition is coated onto a piece of paper. It is not an ink (or a printing plate), contrary to the position taken by the Examiner. See col. 3, lines 28-33, and elsewhere in Cuch et al., which clearly describes a recording material that contains the composition of Cuch et al. Thus, the last thing one would do is to put a black pigment, like carbon black, in a ink receptive layer, since this would destroy the substrate of the paper for printing. One does not print on a black sheet of paper. Thus, the Examiner's alleged substitution with Sampei with the use of carbon black in the composition of Cuch et al. is technically incorrect and would not be a "predictable result" and further, ink pigment particulates are not a "known element" to be used in ink receptive layers, especially the ink receptive layers of Cuch et al. For this additional reason, this rejection should be withdrawn.

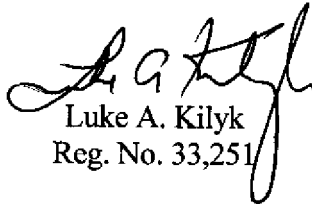
Accordingly, this rejection should be withdrawn.

**CONCLUSION**

In view of the foregoing remarks, the applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 03-0060. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,

  
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